REMARKS

I. Preliminary Remarks

Withdrawal of Restriction Requirement [SEQ ID NOS: 3, 4, and 7]

Applicants respectfully and appreciatively acknowledge the Examiner's withdrawal of the restriction requirement for restriction among SEQ ID NOS: 3, 4 and 7 of Claim 55.

Corrections to the Specification

As requested by the Examiner, Applicants have amended the Abstract to limit its length to 150 words or less, and to delete the word "said" from the Abstract. Also, as requested by the Examiner, the Specification has been amended to delete the duplicate heading "Antisense MN Nucleic Acid Sequences" -- which appeared at page 92, line 1 of the Specification as a result of an apparent proofreading error. The Abstract has also been amended to provide spacing around the dashes that set off the name of the gene "MN" to correct a typographical, proofreading error.

Amendments to the Claims

Claims 32 and 33 have been amended to point out with more particularity and clarity the subject matter regarded by

the Applicants as their invention. As requested by the Examiner, Claims 32 and 33 have been amended to replace the phrase -- "said MN antisense nucleotide" -- with the phrase "said MN antisense oligonucleotide" -- as the latter phrase unambiguously reflects the antecedent phrase "MN antisense oligonucleotide" in Claim 31 (line 5), from which claims 32 and 33 depend.

Applicants respectfully conclude that no new matter has been entered by the above amendments to the Specification and claims.

II. 35 USC 112, Second Paragraph Rejection

Claims 32 and 33 stand rejected under 35 USC 112, second paragraph, for insufficient antecedent basis for "'said MN antisense nucleotide.' . . . [C]laim 31, which claims 32-33 depend from recite 'MN antisense oligonucleotide', not 'MN antisense nucleotide'." [Office Action dated June 27, 2006 ("Office Action"), at page 3.]

Applicants respectfully submit that the above amendments to Claims 32 and 33 address the subject rejection by replacing the phrase "MN antisense nucleotide" with the phrase "MN antisense oligonucleotide." Applicants respectfully request withdrawal of the subject 112 rejection.

III. Nonstatutory Obviousness-Type Double Patenting Rejections [Claims 31-35 and 53-55]

The Office Action states at pages 3-8:

> Claims 31-35 and 53-55 are rejected on the ground of nonstatutory obviousness-type double patenting.
>
> . . . .
>
> Claims 31-34 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5 and 11 of U.S. Patent No. 5,387,676. . . .
>
> . . . .
>
> Claim 35 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 5,387,676, in view of claim 11 of WO 92/04903.
>
> . . . .
>
> Claims 53 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 5,387,676, in view of U.S. Patent No. 5,196,333.
>
> . . . .
>
> Claims 54-55 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 11 of U.S. patent No. 5,387,676.

Applicants respectfully submit that as the instant application and U.S. Patent No. 5,387,676 are commonly owned, that the enclosed terminal disclaimer over U.S. Patent No. 5,387,676

obviates the subject nonstatutory obviousness-type rejection of Claims 31-35 and 53-55.

The Office Action states at page 4:

> A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

The undersigned Attorney for the Applicants declares that the cited U.S. Patent No. 5,387,676 and the instant application are commonly owned.

A terminal disclaimer over U.S. Patent No. 5,387,676 and the required terminal disclaimer fee payment are enclosed. U.S. Patent No. 5,387,676 is cited in each of the above-quoted nonstatutory obviousness-type double patenting rejections of Claims 31-34, Claim 35, Claim 53, and Claims 54-55, respectively. Applicants respectfully conclude that each of the subject nonstatutory obviousness-type double patenting rejections are obviated by the enclosed terminal disclaimer, and respectfully request that the Examiner withdraw the subject double patenting rejections.

Additional Comments

To clarify the record, Applicants respectfully point out that U.S. Patent No. 5,196,333, applied within the nonstatutory nonobviousness-type double patenting rejection of Claim 53 over claim 11 of U.S. Patent No. 5,387,676, has no applicability to the claimed invention. The Office Action states in pertinent part at page 7:

> Claim 53 recites an MN antisense construct comprising a nucleic acid sequence . . . operably linked to an expression control sequence . . . [which] comprises a nucleic acid sequence derived from the MN promoter.
>
> The instant specification discloses that the MN promoter consensus sequences are CAT (CCAAT) or TATA (ATAAATATA) on page 29.
>
> . . . .
>
> It would have been obvious to one of ordinary skill in the art at the time of the invention to operably link the MN antisense construct to the MN promoter sequence containing TATA box in order to control the expression of the MN antisense construct as taught by U.S. Patent NO. 5,196,333.

Applicants respectfully submit that the instant application does not indicate that the consensus sequences mentioned at page 29 of the Specification are the critical expression control sequences for the MN promoter. Instead, the Specification teaches at page 36, lines 4-6: "Figure 25a-b provides the sequence of a MN genomic clone containing a

promoter region [SEQ. ID. NO.: 23]." At page 41, lines 13-18 the Specification states:

> The promoter region is GC-rich and contains one **putative** TATA-box 578 bp upstream from the transcription start. The promoter contains several consensus sequences for binding sites of regulatory elements, including two p53 sites, two AP-2 sites, an AP-1 site, a SP-1 site, and a SDRE site.

[Emphasis added.] Applicants respectfully point out that the Specification refers to "one **putative** TATA-box", but does not state that the MN promoter activity is regulated by a TATA-box and/or a CAT-box sequence(s).

Applicants respectfully conclude that U.S. Patent No. 5,196,333, which teaches the use of a TATA box, capping sequence, and CAAT sequence from the 5' non-transcribing control sequences as expression control sequences, is not applicable to the instant invention. Applicants are respectfully submitting the subject comments in regard to U.S. Patent No. 5,196,333 to clarify the record.

IV. Request for Rejoinder of Method Claims 39-40

In the Restriction Requirement dated February 15, 2006, the Examiner required election of one of three groups, noting that Groups I and II contained claims directed to an MN antisense construct (Claims 31-35 and 53-55) and a method of treatment comprising administering that MN antisense construct

(Claims 39-40), respectively. In the February 16, 2006 Restriction Requirement, the Examiner noted at page 9 that restriction was being required:

> between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier.

[Emphasis in original.]

Applicants respectfully submit that the instant Amendment places the subject Group I claims -- Claims 31-35 and 53-55 -- in condition for allowance, and that in accordance with the February 16 Restriction Requirement, the withdrawn Group II process claims -- Claims 39-40 -- that depend from Claim 31 should "be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier." [*Id.*]

Applicants respectfully request that the restriction requirement between the Group I (Claims 31-35 and 53-55) and Group II (Claims 39-40) be withdrawn, and that Claims 39-40 be

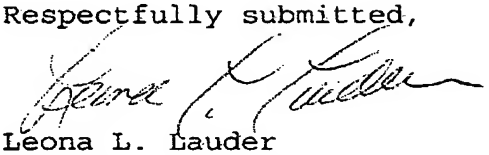
rejoined. Applicants respectfully submit that the requested rejoinder is proper in accordance with MPEP § 821.04(b).

CONCLUSION

Applicants respectfully conclude that Claims 31-35 and 53-55 are in condition for allowance, and earnestly request that the claims be promptly allowed. Applicants further respectfully conclude that the restriction requirement between the Group I product claims and the Group II method claims should be withdrawn, and that the Group II claims, Claims 39-40, should be rejoined and found allowable.

If for any reason the Examiner feels that a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to telephone the undersigned Attorney for Applicants at (415) 981-2034.

Respectfully submitted,



Leona L. Lauder
Attorney for Applicants
Registration No. 30,863

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